the required offer to surrender the original patent.

On March 20, 1998, undersigned counsel left a voice mail message with the Examiner to the effect that there is a passage on page 2 of a paper filed with the reissue application and entitled "Consent of Assignee to Reissue, Offer of Surrender of Letters Patent, Revocation of Power of Attorney and Appointment of New Attorneys," which reads, "The assignee hereby consents to the filing of the subject application for reissue of said patent No. 5,418,537 and offers to surrender said patent No. 5,418,537 as a condition of said reissue."

Undersigned counsel received a voice mail message from the Examiner on March 23, 1998, retracting the statement in the Official Action to the effect that no offer to surrender the original patent had been made. According to the voice mail message, the Examiner had found the offer and determined that it is acceptable.

Accordingly, it is understood that no further action is required with respect to the point made in section 1 on page 2 of the Office Action.

Claims 28-34, 36, 38-40, 42 and 44-49 are rejected under 35 U.S.C. §102(e) as being anticipated by a U.S. patent to Song No. 5,208,756. Claims 35, 37, 41 and 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Song patent in view of the U.S. patent to Darnell et al. No.5,043,736. The

Examiner contends that each feature recited in each of the claims rejected under 35 U.S.C. §102(e) is fully anticipated by the Song patent. The Examiner recognizes that the Song patent does not fully disclose all of the features recited in the claims rejected under 35 U.S.C. §103(a) but contends that the Darnell et al. patent discloses that the location unit 19 can be of the GPS type and concludes that the invention as defined in claims 35, 37, 41 and 43 would have been obvious, at the time the invention was made, to a person having ordinary skill in the art in the light of the Song and Darnell et al. patents.

The rejections are respectfully traversed.

The application as originally filed discloses a paging request responder 19 (Fig. 4 and column 6, lines 32 and 33) and a separate cellular phone connection 23. The invention thus discloses employing a paging request responder to receive a paging request and, in response to the paging request, employing a communications device separate from the paging request responder to transmit a fix to a designated service center.

By thus splitting the functions of the paging request and the communication responsive thereto transmitting a fix of vehicle location to a designated service center, the invention greatly increases the likelihood of locating a missing vehicle.

A paging request responder that does not need to do double service as a cellular telephone, for example, can operate

at very low power. A pager "wakes up" periodically to detect pages, then goes back to sleep. During the sleep mode, it consumes very little power (just sufficient, for example, to operate the quartz crystal of a clock).

A cellular telephone uses many times more power than a pager. In standby mode, it consumes power continuously so that it can detect an incoming call. A hand-held portable cellular phone can operate in standby mode only for a matter of hours until the battery needs recharging. Even if a cellular telephone is connected to the battery of a vehicle, it is capable of running the battery down if the vehicle is left unattended for a long time, for example in an airport parking lot.

Moreover, paging signals have greater penetration into tunnels, etc., than have cellular telephone signals. The use of a paging request responder separate from a cellular telephone thus further increases the likelihood of locating a missing vehicle.

The claims have been amended by amendment of the independent claims to define the invention more precisely. Claim 28, for example, is directed to a method of disclosing the present location of a vehicle, the method comprising the steps of performing in-vehicle processing of signals to obtain a fix of vehicle location, employing a paging request responder to receive a paging request, and, in response to the paging request, employing a communications device separate from the paging

request responder to transmit the fix to a designated service center.

The other independent claims have been similarly amended. Each requires separate paging and fix-transmitting devices or steps. The claims as amended thus are drawn to an invention that can operate reliably for long periods of time and that greatly improves the odds of locating a missing vehicle.

The invention as defined by the amended claims is neither disclosed nor suggested by the Song patent, or that patent in combination with the Darnell et al. patent.

The Song patent discloses that signals transmitted from a set of base stations are detected by a receiver 25, which is a component of a mobile telephone 27, and transmits received signals to circuits 28 of the mobile phone. The patent discloses at column 7, line 48, that those signals may include a paging signal for the mobile phone 27. As the patent discloses at column 7, lines 59-66, the paging signal referred to is a dual tone, multiple frequency (DTMF) signal transmitting a 10-digit number uniquely identifying a particular mobile telephone 27. Clearly, the paging signal of Song is merely a ringing signal for activating the mobile phone.

This presents a user of the system with some unsatisfactory choices. If the mobile phone is left in the off position, it will not respond to an incoming signal, and if the

vehicle is stolen the Song system will not aid in its recovery.

On the other hand, if an owner of the vehicle leaves the mobile phone in the standby position, he runs the risk of discharging the battery that powers it. If that is the same battery that powers the vehicle, the owner may be unable to start the vehicle after leaving it unattended for a time.

As indicated above, a pager/cellphone combination has other benefits as compared to a cellphone by itself, including greater penetration into tunnels and other areas that cause fading of cellular telephone signals.

The Darnell et al. patent contains no disclosure that makes up for the deficiency of the Song patent as a disclosure or suggestion of the present invention as defined in the amended claims. The Darnell et al. patent is in fact not relied upon as supplying any such deficiency; it is cited merely to disclose that location can be determined employing GPS.

Thus neither the Song patent by itself nor that patent in combination with the Darnell et al. patent would have led a person having ordinary skill in the art to the present invention as defined in the amended claims.

It is therefore respectfully requested that the Examiner enter this amendment, withdraw the outstanding rejections, and issue a formal notice of allowance.

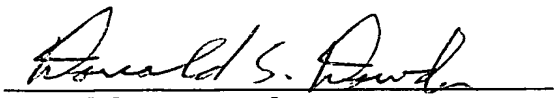
The preceding comments regarding the technical distinctions between the invention as defined in the amended claims and the disclosures in the cited documents represent the present opinion of applicant's undersigned counsel. Should the Examiner disagree therewith, it is requested that it be indicated where, in the cited documents, there is a basis for such disagreement.

In view of the foregoing claim amendments, an unsigned amended reissue declaration is submitted herewith for the Examiner's approval in accordance with MPEP §1444, Rev. 3, July 1997.

If a telephone interview would expedite the prosecution of the application, the Examiner is cordially invited to call undersigned counsel at 212-278-0400.

Respectfully submitted,

COOPER & DUNHAM LLP



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